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Johji Inazawa

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EXAMINER

BOESEN, CHRISTIAN C

ART UNIT

PAPER NUMBER

4131

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,347	<b>Applicant(s)</b> INAZAWA ET AL.	
	<b>Examiner</b> CHRISTIAN BOESEN	<b>Art Unit</b> 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office action is responsive to the communication filed 08/11/2006. Claims 1-12 are pending and subject to the following restriction requirement.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCA3** gene.

II. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCB6** gene.

III. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCB8** gene.

IV. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCB10** gene.

V. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCC4** gene.

VI. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCC9** gene.

VII. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCD3** gene.

VIII. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCD4** gene.

IX. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCE1** gene.

X. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **ABCF2** gene.

XI. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **BCL2L2** gene.

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XII. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **BCL2L10** gene.

XIII. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **BCL2L1** gene.

XIV. Claims 1-8, drawn to a method of detecting acquisition of the drug resistance of a test cancel cell to anticancer drugs by detecting amplification of the **BCL2L1 A1** gene.

XV. Claims 9-12, drawn to a DNA fixed substrate of the **ABCA3** gene.

XVI. Claims 9-12, drawn to a DNA fixed substrate of the **ABCB6** gene.

XVII. Claims 9-12, drawn to a DNA fixed substrate of the **ABCB8** gene.

XVIII. Claims 9-12, drawn to a DNA fixed substrate of the **ABCB10** gene.

XIX. Claims 9-12, drawn to a DNA fixed substrate of the **ABCC4** gene.

XX. Claims 9-12, drawn to a DNA fixed substrate of the **ABCC9** gene.

XXI. Claims 9-12, drawn to a DNA fixed substrate of the **ABCD3** gene.

XXII. Claims 9-12, drawn to a DNA fixed substrate of the **ABCD4** gene.

XXIII. Claims 9-12, drawn to a DNA fixed substrate of the **ABCE1** gene.

XXIV. Claims 9-12, drawn to a DNA fixed substrate of the **ABCF2** gene.

XXV. Claims 9-12, drawn to a DNA fixed substrate of the **BCL2L2** gene.

XXVI. Claims 9-12, drawn to a DNA fixed substrate of the **BCL2L10** gene.

XXVII. Claims 9-12, drawn to a DNA fixed substrate of the **BCL2L1** gene.

XXVIII. Claims 9-12, drawn to a DNA fixed substrate of the **BCL2L1 A1** gene.

The inventions listed in group's I-XXVIII do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features for the following reasons: the shared technical feature of the claimed invention is a method of detecting acquisition of the drug resistance of a test cancer cell to anticancer drugs.

Zhang (2004 International Journal of Cancer volume 108 page 212) teaches a DNA immobilized substrate was prepared from a promyelocytic leukemia cell for observing the change of gene expression caused by administering cantharidin to the said cell, and (2) the expression of

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ABCA3 gene decreased (see Table 1). The document (page 216, right column, lines 25-40) further describes to the effect that a cancer cell overexpressing a so-called multiple drug resistant gene shows resistance to a wide range of drugs and above all, the change in the expression of an ABC transporter gene participates in the said resistance and also to the effect that the decline in the expression of ABCA3 gene caused by the administration of cantharidin is consistent with the enhancement of susceptibility of cancer cells to drugs.

Since applicant's invention does not contribute a special technical feature when viewed over the prior art they do not have a single inventive concept and thus the claims lack unity of invention. Therefore, the instant invention lacks Unity of Invention and restriction is set forth as it applies to U.S. practice.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Species Election***

This application contains claims directed to the following patentably distinct species:  
applicant is required to further elect **a single ultimate species for each** of the following:

If applicant elects group I:

- A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]
- B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

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If applicant elects group II:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group III:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group IV:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group V:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group VI:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).



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If applicant elects group VII:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group VIII:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group IX:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group X:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

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If applicant elects group XI:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group XII:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group XIII:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group XIV:

A. A single specific species selection of CGH method OR the flow cytometry method OR the ELISA method OR the DNA chip method OR the quantitative PCR method (claims 3-4). [If any of the following the flow cytometry method OR the ELISA method OR the quantitative PCR method are elected then claim 4 will be withdrawn.]

B. A single specific species selection of ABCB 1 gene OR ABCC1 gene OR ABCB11 gene OR BCL2 gene OR MCL1 gene OR BCLXL gene OR DCK1 gene OR TOP1 gene OR TOP2A gene (claim 6).

If applicant elects group XV:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

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If applicant elects group XVI:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XVII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XVIII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XIX:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XX:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

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If applicant elects group XXI:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXIII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXIV:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXV:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXVI:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

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If applicant elects group XXVII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

If applicant elects group XXVIII:

A. A single specific species selection of genomic DNAs OR cDNAs OR synthetic oligonucleotide (claim 11). [If cDNAs is elected then claim 12 will be withdrawn. If synthetic oligonucleotide is elected then claim 12 will be withdrawn.]

1. If applicant elects genomic DNAs then a single specific species selection of BAC DNA or YAC DNA or PAC DNA (claim 12).

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

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**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

### ***Consideration of Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Correction of Inventorship***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN BOESEN whose telephone number is 571-270-1321. The examiner can normally be reached on Monday-Friday 9:00 AM to 5:00 PM.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTIAN BOESEN/  
Examiner, Art Unit 1639

/James O. Wilson/  
Supervisory Patent Examiner, AU 1624